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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TRMB1412

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on 05/23/06

Signature

Typed or printed name

Mary Elias

Application Number

10/651,586

Filed

08/29/2003

First Named Inventor

Dennis York

Art Unit

2182

Examiner

Tammara R. Peyton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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5/23/06

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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Remarks Accompanying Pre-Appeal Brief Request For Review

In response to the final Office Action dated February 23, 2006, Applicants respectfully request a review of the final rejection in the above-identified application. Applicants respectfully submit that the Examiner's rejections of the Claims 1-20 under 35 USC 102(b) as being anticipated by Ross et al (5,859,628) is improper as an essential element needed for a proper prima facie rejections is missing (e.g., the teaching of all of the recited claim limitations).

Rejection under 35 U.S.C. §102 (b)

KEY CLAIM LIMITATIONS THAT ARE NOT MET BY THE CITED REFERENCES

Claims 1 and 15 set forth a processing unit for an electronic instrument comprising:

- a signal/data processor;
- an exposed external electrical contact for receiving electric power input;
- an exposed external electrical contact for receiving an electric signal input;
- an exposed external electrical contact for transmitting an electrical signal output;

and

- a housing comprising mechanical retention features for securely attaching a battery/input/output module.

In the final Office Action, the Examiner has referenced Figure 2 of Ross et al. as containing subject matter that anticipates the aforementioned features of Claims 1 and 15. The Appellant respectfully disagrees with the Examiner. That is, the Appellant does not understand Ross et al. to anticipate the features of Claims 1 and 15.

In the Office Action, the Examiner equates components 510, 512, and 514 of Ross et al. with the exposed electrical contacts of the Present invention.

According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration” (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Appellant does not understand the components 510, 512, and 514 of Ross et al. to anticipate the features of Claims 1 and 15. Assuming arguendo that component 510 of Ross et al. anticipates an electric power input, Appellant respectfully disagrees that the component 510 of Ross et al. anticipates the Claimed features of either an external

electrical contact for receiving an electric signal input or an external electrical contact for transmitting an electrical signal output.

Components 512 and 514 do not overcome the shortcomings of component 510. Appellant understands Ross et al. to teach that the push pins 310 contact flexible contact strips 512 on the bottom of PDA 102 which are connected to the power input port 510 via line 514. The flexible contact strips 512 include conductors connected to power input port 510. Each strip has an exposed portion corresponding to one of push pins 310. The exposed portions of strips 512 are positioned so that they are in electrical contact with push pins 310 when PDA 102 is in cradle 104. In this manner, power supply 108 is connected to PDA 102 through cradle 104 for providing power to PDA 102. Moreover, Appellant understands Ross et al. to teach that cradle 104 also includes spring-loaded DC contacts, such as push pins 310, for connecting DC output 112 to either the battery unit 114 or the power input port (see FIG. 5) of PDA 102 (emphasis added).

Again, assuming arguendo that components 510, 512 and 514 provide a method for receiving electric power input from DC contacts, Appellant respectfully disagrees that the components 510, 512 and 514 of Ross et al. anticipates the Claimed features of either an external electrical contact for receiving an electric signal input or an external electrical contact for transmitting an electrical signal output.

Therefore, Appellant respectfully states that Ross et al. does not anticipate the features of an exposed external electrical contact for receiving an electric signal input; and an exposed external electrical contact for transmitting an electrical signal output as claimed in Independent Claims 1 and 15. As such, the rejection under 35 U.S.C. §102(b) is improper and should be reversed.

Additional arguments provided on pages 6-8 of the response to the Non-Final Office Action dated June 29, 2005 are also referenced.

Regarding Claims 1-7 and 16-20, Appellant respectfully submits that Claims 1-7 and 16-20 are also allowable as pending from allowable base Claims and reciting further features of the Claimed invention.

Furthermore, the Examiner has stated on page 5 in the response to Applicant's arguments that the Applicant argues that Claims 1, 8 and 15 teach "a portable

battery/input/output module...” Appellant respectfully disagrees with the Examiner’s assertion.

Specifically, Appellant respectfully disagrees with the Examiner’s statement that the Applicant argued that Claim 1 teaches “a portable battery/input/output module...” Appellant respectfully states that the arguments provided on pages 6-8 of the response to the Non-Final Office Action dated June 29, 2005 clearly support the Appellant’s statement.

Claims 8 and 15 set forth a portable battery/input/output module for a portable electronic instrument comprising:

- a storage device for electric energy;
- an exposed external electrical contact for transmitting electric power;
- an exposed external electrical contact for receiving an electric signal input;
- an exposed external electrical contact for transmitting an electrical signal output;
- a housing comprising mechanical retention features for securely attaching a processing unit.

In the final Office Action, the Examiner has referenced Figure 3 of Ross et al. as containing subject matter that anticipates the aforementioned features of Claims 8 and 15. The Appellant respectfully disagrees with the Examiner. That is, the Appellant does not understand Ross et al. to anticipate the features of Claims 8 and 15.

In the Office Action, the Examiner equates components 310 and 316 of Ross et al. with the exposed electrical contacts of the Present invention.

Appellant does not understand the components 310 and 316 of Ross et al. to anticipate the features of Claims 8 and 15. Assuming arguendo that component 310 transmits electric power, Appellant respectfully disagrees that the component 310 of Ross et al. anticipates the Claimed features of either an external electrical contact for receiving an electric signal input or an external electrical contact for transmitting an electrical signal output.

Component 316 does not overcome the shortcomings of component 310. Appellant understands Ross et al. to teach that the component 316 is an IR data link.

According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration” (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Appellant respectfully disagrees that the component 316 of Ross et al. is an external electrical contact. That is, Appellant does not understand an IR link to be an exposed electrical contact. (emphasis added)

Therefore, Appellant respectfully states that Ross et al. does not anticipate the features of an exposed external electrical contact for receiving an electric signal input or an exposed external electrical contact for transmitting an electrical signal output as claimed in Independent Claims 8 and 15 and as such the rejection under 35 U.S.C. §102 (b) is improper and should be reversed.

Additional arguments provided on pages 6-8 of the response to the Non-Final Office Action dated June 29, 2005 are also referenced.

Regarding Claims 9-14 and 16-20, Appellant respectfully submits that Claims 9-14 and 16-20 are also allowable as pending from allowable base Claims and reciting further features of the Claimed invention.

Furthermore, Claims 8 and 15 include the feature “a portable battery/input/output module.” The Examiner has stated on page 5 in the response to Applicant’s arguments, that Ross et al. teaches a portable battery/input/output module because housing 104 of Ross et al. is part of an automobile which is inherently a portable device.

Appellant respectfully disagrees with the Examiner’s assertion. Specifically, Appellant respectfully disagrees with the Examiner’s statement that an automobile is an inherently portable device.

Appellant respectfully submits that the term portable is derived from Latin *portare* to carry. Moreover, Appellant submits that the specification clearly defines the portability including in the description of Figure 1 wherein the portability is described as “a handheld instrument comprising a processing unit 105 and a battery/input/output module 110 in accordance with an embodiment of the present invention.” (emphasis added).

Thus, Appellant respectfully submits the "portable module" words of the claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). Moreover, the portable terminology is clearly defined in the Specification and the Figures as being of a size to be held or carried.

Appellant respectfully submits that an automobile is clearly not an inherently portable device. An automobile is not inherently carried, nor is it inherently handheld. Moreover, Appellant does not understand Ross et al. to teach, anticipate or try to define the automobile as portable or handheld. Therefore, Appellant respectfully submits that the Examiner's statement that an automobile is inherently portable is incorrect and therefore the rejection of Claims 8 and 15 is incorrect and should be withdrawn.

Regarding Claims 10-13, Appellant did not find any reasons cited by the Examiner for the rejection of Claims 10-13. For this reason, Appellant submits that the undisclosed rejection of Claims 10-13 is improper and should be withdrawn.

In summary, Appellant respectfully submits that the Examiner's rejections of the Claims are improper as key limitations needed for proper prima facie rejections of Applicants' Claims are not met by the cited reference as outlined above. Moreover, because key limitations of independent Claims 1, 8 and 15 (from which Claims 2-7, 9-14 and 16-20 pend) are not anticipated by Ross et al. Therefore, Appellant respectfully submits that the rejection of Claims 1-20 under 35 U.S.C. §102 (b) as being anticipated by Ross et al. is improper and should be reversed.